

Rec'd PCT/PTO 14 AUG 2001

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH  
THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL IN AN  
ENVELOPE ADDRESSED TO: ASSISTANT COMMISSIONER FOR PATENTS.

WASHINGTON, D.C. 20231, ON 14 August 2001

Audrey Boyd  
August 14, 2001

DATE

Attorney Docket No. P32085

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Barton, et al.

14 August 2001

Serial No.: 09/743,209

Group Art Unit No.: Not Yet Assigned

Filed: 15 July 1999

Examiner: Not Yet Assigned

For:

**PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING  
POLYPEPTIDES HAVING BETA-LACTAM SYNTHETASE ACTIVITY**

**RECEIVED**

24 AUG 2001

Legal Staff

International Division

Assistant Commissioner for Patents  
Washington, D.C. 20231

PETITION FOR FILING BY OTHER THAN ALL THE INVENTORS (37 CFR 1.47)(a)

Applicants hereby petition the Commissioner of Patents and Trademarks for filing an application for patent by other than all the inventors. Accompanying this petition is a Declaration on behalf of the Non-signing Inventors, and a Statement of Facts in Support of Filing on Behalf of the Non-signing Inventors.

Please charge the requisite petition fee under 37 CFR 1.17(i) of \$130.00 to Deposit Account No. 19-2570. Two duplicate copies of this form are enclosed.

Please charge any additional fees which may be required by this paper, or credit any overpayment, to Deposit Account No. 19-2570.

11 17 2001 0024VITE 0000018E 192570 06740209

11 17 2001 130.00 US

Respectfully submitted,

Zoltan Kerekes

Attorney for Applicants  
Registration No. 38.938

GLAXOSMITHKLINE

Corporate Intellectual Property - UW2220

P.O. Box 1539

King of Prussia, PA 19406-0939

Phone (610) 270-5024

Facsimile (610) 270-5090

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING  
DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-  
CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT  
COMMISSIONER OF PATENTS, WASHINGTON, D.C. 20231, ON

14 August 2001

*Andrew Boyd*  
*August 14, 2001*

DATE

Attorney Docket No. P32085

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Barton, et al.	14 August 2001
Serial No.:	09/743,209	Group Art Unit No.: Not Yet Assigned
Filed:	15 July 1999	Examiner: Not Yet Assigned

For: **PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING  
POLYPEPTIDES HAVING BETA-LACTAM SYNTHETASE ACTIVITY**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NON-SIGNING  
INVENTOR**

1. We, Fiona Reardon, Senior Patent Administrator, and Dawn Ferrier, Patent Administrator, employed by GSK make this statement to establish the diligent effort made to secure the execution of the declaration by the non-signing inventors for the above-identified patent application.
2. The non-signing inventors are Christopher Joseph SCHOFIELD and Heather Jane MCNAUGHTON. Christopher Joseph SCHOFIELD and Heather Jane MCNAUGHTON, co-inventors of the present application, were employed by Dyson Perrins Lab at the time the invention was made. The other inventors, Barry BARTON and Jan THIRKETTLE, are GSK employees. The last known addresses of the non-signing Inventors are as follows:

Christopher Joseph SCHOFIELD  
Dyson Perrins Lab  
South Park Road  
Oxford  
OX1 3QY, United Kingdom

Heather Jane MCNAUGHTON  
Dyson Perrins Lab  
South Park Road  
Oxford  
OX1 3QY, United Kingdom

3. We have made two attempts to contact the non-signing Inventors at their last known address. On 11 June 2001, Fiona Reardon sent an envelope containing a cover letter, a Declaration/Power of attorney, and Assignment via ordinary Mail (a copy of the cover letter is attached as Exhibit A). We did not receive a response. On 27 July 2001, Dawn Ferrier sent a second envelope containing a cover letter, a Declaration/Power of Attorney, and Assignment via registered mail (a copy of the registered mail slip enclosed as Exhibit B). Again, We received no response from the non-signing Inventors.
4. We hereby declare that all statement made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereof.

Date: \_\_\_\_\_

9 August 2001

\_\_\_\_\_  
Fiona Reardon

*Fiona Reardon*

Date: \_\_\_\_\_

9 August 2001

\_\_\_\_\_  
Dawn Ferrier

*Dawn Ferrier*

GLAXOSMITHKLINE  
Corporate Intellectual Property - UW2220  
P.O. Box 1539  
King of Prussia, PA 19406-0939  
Phone (610) 270-5024  
Facsimile (610) 270-5090

Exhibit A

Tel: 020 8975 6173  
Fax: 020 8975 6294

**27 JUL 2001**

Our Ref ML/DF/P32085

**Registered Post**

Process C J Schofield and Ms H J McNaughton  
Dyson Perrins Lab  
South Park Road  
Oxford  
OX1 3QY

Dear Professor Schofield and Ms McNaughton

**GSK Patent Case P32085 – Process for Preparing Clavum Derivatives by Using Polypeptides having Beta-Lactam Synthetase Activity**

Further to our recent communication on this matter I am writing to confirm if the forms relating to this patent application have ever been received.

If you have not received the forms please let me know and I will send a new set for your signatures.

Thank you for your assistance in this matter

Yours sincerely

  
Dawn Ferrier  
IP Administrator

Direct Line: 020 8975 6167  
Fax: 020 8975 6294

Our Ref: ML/FR/P32085

Professor C J Schofield and Ms H J McNaughton  
Dyson Perrins Lab  
South Park Road  
Oxford  
OX1 3QY

11 JUN 2001

Dear Professor Schofield and Ms McNaughton

**GSK Patent Case No P32085 – Process for Preparing Clavam Derivatives by  
Using Polypeptides having Beta-Lactam Synthetase Activity**

We have recently filed the above case nationally in a number of countries and there are now several forms that have to be signed by all inventors named on the application. The forms are enclosed as follows:

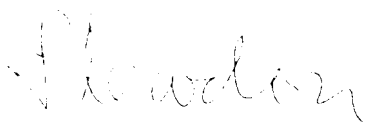
Canada	Assignment – this form must also be completed by a witness where indicated
USA	Declaration/Power and Attorney
USA	Assignments in duplicate. Please sign both copies of the Assignment.

Once signed and dated, please return the forms to me in the enclosed envelope.

Thank you for your assistance and should you have any questions, please do not hesitate to contact me.

With best wishes,

Yours sincerely



Fiona Reardon  
Senior I.P. Administrator

In consideration of One (\$1.00) dollar, and other good and valuable consideration paid to us by

SmithKline Beecham p.l.c.,

hereinafter called the Assignees, the receipt whereof is hereby acknowledged, we do hereby sell and assign unto the said Assignee, all our right, title and interest in Canada and to our invention relating to:

PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING POLYPEPTIDES HAVING  
BETA-LACTAM SYNTHETASE ACTIVITY

as fully described and claimed in the application for a patent for such invention and to all our corresponding right, title and interest in and to any patent which may issue therefor.

Signed at: \_\_\_\_\_, this \_\_\_\_\_ day of \_\_\_\_\_ 2001

Inventor: \_\_\_\_\_  
BARRY BARTON

Signed at: \_\_\_\_\_, this \_\_\_\_\_ day of \_\_\_\_\_ 2001

Inventor: \_\_\_\_\_  
HEATHER JANE MCNAUGHTON

Signed at: \_\_\_\_\_, this \_\_\_\_\_ day of \_\_\_\_\_ 2001

Inventor: \_\_\_\_\_  
CHRISTOPHER JOSEPH SCHOFIELD

Signed at: \_\_\_\_\_, this \_\_\_\_\_ day of \_\_\_\_\_ 2001

Inventor: \_\_\_\_\_  
JAN EDWARD THIRKETTLE

**WITNESS**

I, \_\_\_\_\_,  
whose full post office address is

hereby declare that I was present and did see HEATHER JANE MCNAUGHTON and  
CHRISTOPHER JOSEPH SCHOFIELD sign this document before me today.

Date: \_\_\_\_\_ Signature of Witness: \_\_\_\_\_

## DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING POLYPEPTIDES HAVING  
BETA-LACTAM SYNTHETASE ACTIVITY

the specification of which (check one)

☐ is attached hereto.

☒ was filed on 15 July 1999 as Serial No. PCT/GB99/02301  
and was amended on (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Number	Country	Filing Date	Priority Claimed
9815666.4	Great Britain	17 July 1998	Yes

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below.

Application Number	Filing Date
--------------------	-------------

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

Serial No.	Filing Date	Status
------------	-------------	--------

I hereby appoint the practitioners associated with the Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and direct that all correspondence be addressed to that Customer Number:

Customer Number 20462.

Address all correspondence and telephone calls to Zoltan Kerekes, SmithKline Beecham Corporation, Corporate Intellectual Property-U.S., UW2220, P.O. Box 1539, King of Prussia, Pennsylvania 19406-0939, whose telephone number is 610-270-5024.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Inventor: BARRY BARTON

Inventor's Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: Worthing, West Sussex, England

Citizenship: British

Post Office Address: SmithKline Beecham Corporation  
Corporate Intellectual Property - UW2220  
P.O. Box 1539  
King of Prussia, Pennsylvania 19406-0939

Full Name of Inventor: HEATHER JANE MCNAUGHTON

Inventor's Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: Oxford, Oxfordshire, England

Citizenship: British

Post Office Address: SmithKline Beecham Corporation  
Corporate Intellectual Property - UW2220  
P.O. Box 1539  
King of Prussia, Pennsylvania 19406-0939



Full Name of Inventor: CHRISTOPHER JOSEPH SCHOFIELD

Inventor's Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: Oxford, Oxfordshire, England

Citizenship: British

Post Office Address     SmithKline Beecham Corporation  
                                 Corporate Intellectual Property - UW2220  
                                 P.O. Box 1539  
                                 King of Prussia, Pennsylvania 19406-0939

Full Name of Inventor: JAN EDWARD THIRKETTLE

Inventor's Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: Worthing, West Sussex, England

Citizenship: British

Post Office Address.     SmithKline Beecham Corporation  
                                 Corporate Intellectual Property - UW2220  
                                 P.O. Box 1539  
                                 King of Prussia, Pennsylvania 19406-0939

ASSIGNMENT

WHEREAS I/We, BARRY BARTON and JAN EDWARD THIRKETTLE of Worthing, West Sussex, England and HEATHER JANE MCNAUGHTON and CHRISTOPHER JOSEPH SCHOFIELD of Oxford, Oxfordshire, England have made an invention entitled:

PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING POLYPEPTIDES  
HAVING BETA-LACTAM SYNTHETASE ACTIVITY

for which on \_\_\_\_\_ I/we  
executed an application for Letters Patent of the United States of America:

NOW, THEREFORE, in return for valuable consideration paid to me/us by SmithKline Beecham p.l.c. of New Horizons Court, Brentford, Middlesex TW8 9EP, United Kingdom (hereinafter "ASSIGNEE"), the receipt of which is hereby acknowledged and intending to be legally bound, I/we do hereby assign unto the said ASSIGNEE, its successors and assigns, the entire right, title and interest in and to the said invention, said executed application, any division, continuation and continuation-in-part of said application and reissue applications, and all Letters Patents of the United States of America to be obtained therefor:

I/we hereby covenant that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment and sale:

In addition I/we agree to provide ASSIGNEE upon its request with all pertinent facts and documents relating to said invention, and said Letters Patent as may be known and accessible to me/us, and to testify as to the same in any interference or litigation related thereto, and to execute further instruments (including divisional, continuation, continuation-in-part or reissue applications, affidavits or other instruments) required to apply for, obtain, maintain and enforce said application and said Letters Patent which may be necessary; this agreement to be binding upon my/our heirs, executors and administrators.

\_\_\_\_\_  
Inventor 1  
BARRY BARTON

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 2  
HEATHER JANE MCNAUGHTON

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 3  
CHRISTOPHER JOSEPH SCHOFIELD

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 4  
JAN EDWARD THIRKETTLE

Date: \_\_\_\_\_

ASSIGNMENT

WHEREAS I/We, BARRY BARTON and JAN EDWARD THIRKETTLE of Worthing, West Sussex, England and HEATHER JANE MCNAUGHTON and CHRISTOPHER JOSEPH SCHOFIELD of Oxford, Oxfordshire, England have made an invention entitled:

PROCESS FOR PREPARING CLAVAM DERIVATIVES BY USING POLYPEPTIDES  
HAVING BETA-LACTAM SYNTHETASE ACTIVITY

for which on \_\_\_\_\_ I/we  
executed an application for Letters Patent of the United States of America:

NOW, THEREFORE, in return for valuable consideration paid to me/us by SmithKline Beecham p.l.c. of New Horizons Court, Brentford, Middlesex TW8 9EP, United Kingdom (hereinafter "ASSIGNEE"), the receipt of which is hereby acknowledged and intending to be legally bound, I/we do hereby assign unto the said ASSIGNEE, its successors and assigns, the entire right, title and interest in and to the said invention, said executed application, any division, continuation and continuation-in-part of said application and reissue applications, and all Letters Patents of the United States of America to be obtained therefor;

I/we hereby covenant that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment and sale;

In addition I/we agree to provide ASSIGNEE upon its request with all pertinent facts and documents relating to said invention, and said Letters Patent as may be known and accessible to me/us, and to testify as to the same in any interference or litigation related thereto, and to execute further instruments (including divisional, continuation, continuation-in-part or reissue applications, affidavits or other instruments) required to apply for, obtain, maintain and enforce said application and said Letters Patent which may be necessary; this agreement to be binding upon my/our heirs, executors and administrators.

\_\_\_\_\_  
Inventor 1  
BARRY BARTON

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 2  
HEATHER JANE MCNAUGHTON

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 3  
CHRISTOPHER JOSEPH SCHOFIELD

Date: \_\_\_\_\_

\_\_\_\_\_  
Inventor 4  
JAN EDWARD THIRKETTLE

Date: \_\_\_\_\_

**MAILROOM RECEIPT**

Received:- \_\_\_\_\_ envelope(s)/package(s)/parcel(s)-

From:- Dawson \_\_\_\_\_

To:- (Name) Mr. J. C. Scott \_\_\_\_\_

(Town) DYSON \_\_\_\_\_  
15/2/20 \_\_\_\_\_

For Despatch by:- \_\_\_\_\_ Registered Post/Recorded Delivery/RMSD/Datapost

Others (Specify) Sp. Delivery \_\_\_\_\_

Control Number Allocated:- 519313695 \_\_\_\_\_

Date:- 21/7/21 \_\_\_\_\_ Signed:- \_\_\_\_\_